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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,745	10/31/2003	Gary Lee Moses	017109.0381	3156

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EXAMINER


CONSILVIO, MARK J

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/698,745	MOSES ET AL.	
	Examiner	Art Unit	
	Mark Consilvio	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/15/2005</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on 2/15/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Response to Arguments*

Applicant's arguments filed 3/15/2005 have been fully considered but they are not persuasive.

First, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would generally recognize the desirability to protect a lens element. Also, it is well known that housings may be provided for protection of lens elements. Further, a variety of housings for angled lens elements are known in the art as evidenced by the applicant's own submission of prior art filed 2/15/2005. Therefore, the combination, as set forth infra, would have been obvious to one of ordinary skill at the time of the invention.

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And second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the examiner notes that the citation of the Horan reference is provided to evidence a microscope drape with a protective housing for an objective lens element. It is for this reason that the Horan reference has been applied and deemed a properly combinable with the Pascal reference.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-10, 13-19 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paschal (US Patent No. 6,116,741) in view of Horan et al. (US Patent No. 6,024,454).

With respect to claims 1, 14, 15, 22-24, and 27, firstly Paschal shows a microscope drape coupling system (200) comprising a first adapter (300) having a first objective lens barrel aperture (327) and a first mounting ring (325) coupled to the first adapter (300) (see figs. 1-4B). Also, Paschal shows the mounting ring (325) having a first mounting aperture (237) configured to couple the first adapter (300) to a first objective lens barrel (140) of a first microscope (100) (see figs. 1-4B). Further, Paschal shows a second adapter (450) having a second objective lens

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barrel aperture (427) and a second mounting ring (455) coupled to the second adapter (450) (see figs. 1-4B). Though not expressly stated or numbered, Paschal clearly shows or implies a second mounting aperture configured to couple the second adapter to a second objective lens barrel of a second microscope (see figs. 4A and 4B and col. 6, lines 14-28). Further still, Paschal discloses the second mounting aperture having a diameter smaller than the first mounting aperture (see col. 6, lines 14-28). And finally Paschal shows a substantially flat transparent protective lens (310) such that a geometric normal to the transparent protective lens forms an angle with respect to a longitudinal axis of either the first or second objective lens barrel when the adapter is coupled to either the first or second objective lens barrel (see figs. 5A-5C).

While Paschal does not expressly disclose a housing for the protective lens (310), Paschal does show the lens held in place by a plurality of locking tabs (323) (see Paschal fig. 5A). Paschal also shows each locking tab (323) comprises a tongue adapted to engage a groove for rotatably coupling the lens (310) to the first adapter (300) and the lens (310) is selectively removable from the first adapter (300) via the locking tabs (323) (see Paschal fig. 5A). Horan et al. shows a housing (30) for a flat transparent protective lens (34) having a plurality of locking tabs (36) disposed around a perimeter (32) thereof (see Horan et al. figs. 4 and 5). The examiner also notes that while the locking tabs and tongues of Paschal are formed on the adapter and the groove of Pascal is formed on the protective lens, the locking tabs (36) of Horan et al. are formed with a tongue-like tabs (36 in fig. 5) on the housing (30) and adapted to engage a groove (36 in fig. 4) formed on a coupling element (27). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Paschal and Horan et al. to provide a housing for the angled protective lens. One of ordinary skill in the art

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would have been motivated to do this allow the lens to be more easily handled during replacement or cleaning and thus allowing the lens to be placed and cleaned without accidentally scratching or marking the surface of the lens. The examiner also notes that at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to form the locking tabs on the housing and the groove on the adapter since it has been held that the reversal of parts is an obvious modification. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955)

With respect to claims 2 and 19, Paschal discloses the first and second mounting rings are each formed from a flexible material such that the first and second mounting rings are each adapted to elastically constrict about the first and second objective lens barrels, respectively. (See Paschal col. 5, lines 47-64)

With respect to claims 5, 16 and 25, Paschal shows the second adapter (450) comprises a plurality of protrusions (453) configured to rotatably couple the second adapter (450) to the first adapter (300) (see fig. 4B).

With respect to claims 17 and 26, Paschal shows the first adapter (300) further comprises an annular surface (320) disposed around a perimeter thereof, the annular surface (320) adapted to couple to a drape (210) (see figs. 2 and 3A).

With respect to claims 6-10 and 13, the examiner notes while Paschal and Horan et al. are silent to a method of using such a device, the steps of providing, coupling are very broad. Since the structure taught by Paschal and Horan et al. meets applicant's claimed limitations in claims 1, 2, 5, and 17, it would require only routine skill to use the structure to provide a sterile, sealed barrier against contamination by following the steps recited in claims 6-10, and 13.

Claims 3, 4, 11, 12, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paschal (US Patent No. 6,116,741) in view of Horan et al. (US Patent No. 6,024,454) and in further view of Treace (US Patent No. 3,528,720).

With respect to claim 3, 4, 20, and 21, while Paschal and Horan et al. do not expressly disclose additional tabs to frictionally grip the objective barrel, it would take only routine skill in the art to substitute the resilient gasket of Paschal for any reasonable frictional gripping means. Treace provides evidence of and motivation for tab-like gripping means. Treace teaches a mounting ring (55) comprising a plurality of tabs (55a and 55b) extending inwardly from an objective lens barrel aperture (63), wherein a mounting aperture can be defined by the inside edges of each tab (see figs. 4 and 5 and col. 4, line 41-col. 5, line 17). Further, Treace discloses these tabs are desired to, "permit slight changes in the diameter of the frusto-conical body for accommodating various diameters of objective lens frames" and "affords a constricting resilient function to the annular body for frictionally securing the objective lens ring to a particular size telescope objective lens" (see col. 5, lines 10-17).

With respect to claims 11 and 12, the examiner notes while Paschal and Horan et al. are silent to a method of using such a device, the steps of providing, coupling are very broad. Since the structure taught by Paschal, Treace, and Horan et al. meets applicant's claimed limitations in claims 3 and 4, it would require only routine skill to use the structure to provide a sterile, sealed barrier against contamination by following the steps recited in claims 11 and 12.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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